

REISSUE LITIGATION

Raymond Degner et al.

Reissue Appln. 10/734,073 Filed Dec. 12, 2003

For: COMPOSITE ELECTRODE FOR PLASMA

Protester: Xycarb Ceramics, Inc.

Attorney Docket: 01-9665-06.4 Attorney: John E. Wagner

(818) 957-3340

REISSUE LITIGATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re: Reissue Patent Application of Raymond DEGNER et al.
Application No.: 10/734,073 (Reissue)
Filed: December 12, 2003
For: COMPOSITE ELECTRODE FOR PLASMA PROCESSES
Group Art Unit: 1744
Examiner: (Unknown)
Status: Published March 9, 2004

Docket: 01-9665-06.4

Date: May 8, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Director, Technology Center 1700

Enclosed please find:

1. This transmittal letter with Deposit Account Authorization (with copy)
2. Power of Attorney
3. Protest Under CFR 1.291(a) (6 pages)
4. Information Disclosure Statement (1 page)

Ref. A 4,385,979 Pierce et al.

Ref. B publication McGuire (excerpts)

Ref. C 4,564,435 Wickersham

Ref. D 4,931,135 Horiuchi

Ref. E 4,820,371 Rose

Ref. F 4,904,621 Loewenstein

Ref. G 4,367,114 Steinberg

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Ref. H 4,297,162 Mundt

Ref. I 4,963,713 Horiuchi

Ref. J '378 Rose

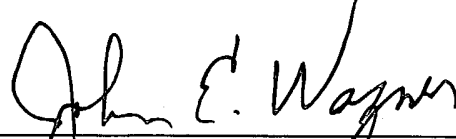
Ref. K 4,544,091 Hidler

5. Copies of Refs. A-K on the Information Disclosure Statement above
6. Attachments I, II, and III from Case 3:03-cv-01335 Northern District of California
7. Declaration of JW verifying authenticity of Attachments I, II, III, and IV
8. Attachment I
 SUPPLEMENTAL DECLARATION OF PATRICK MICHAEL IN
 SUPPORT OF LAM RESEARCH CORPORATION'S
 APPLICATION FOR TEMPORARY RESTRAINING ORDER
9. Attachment II
 LAM RESEARCH CORPORATION'S REPLY BRIEF IN
 SUPPORT OF APPLICATION FOR TEMPORARY RESTRAINING
 ORDER TO ENJOIN XYCARB CERAMICS FROM INFRINGING
 PATENT '456
10. Attachment III
 LAM RESEARCH CORPORATION'S APPLICATION
 FOR TEMPORARY RESTRAINING ORDER TO ENJOIN XYCARB
 CERAMICS, INC. FROM INFRINGING PATENT '456
- Attachment IV
 McGraw Hill SCIENTIFIC DICTIONARY
11. Listing of CLAIM COMPARISON SHEETS
12. CLAIM COMPARISON SHEETS (60 sheets)
13. Proof of Service on Opposing Counsel
14. Postcard

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Please charge any filing fees or fees and credit any overpayment to Deposit Account No. 23-0083. A duplicate of this cover sheet is enclosed.

Respectfully submitted,



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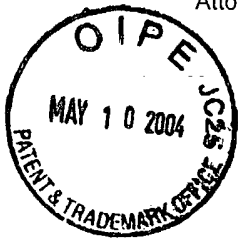
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Enclosures As Stated Above

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Patent
Attorney Docket No. 01-9665-06.4

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Raymond DEGNER et al.)	
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Application No.: 10/734,073 (Reissue))	Group Art Unit: 1744
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For: COMPOSITE ELECTRODE FOR)	Status: Published March 9, 2004
PLASMA PROCESSES)	
)	Attention: Director, Technology
)	Center 1700

**PROTEST OF XYCARB CERAMICS, INC.
UNDER 37 C.F.R. 1.291(a)
TO THE REISSUE OF U.S. PATENT 5,074,456**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Sir:

TC 1700

Xycarb Ceramics, Inc., a Texas corporation, with a principal place of business at 101 Inner Loop Road, Georgetown, Texas 78626, hereby protests the reissue application of U.S. Patent 5,074,456, (hereinafter Degner '456 Patent) by its owner of record, LAM Research Corporation. The Protest extends to the unpatentability of all 36 claims of the reissue application, in view of the prior art accompanying this Protest. The Degner '456 Patent, as noted in the Reissue Application, is the subject of litigation

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between the parties to this Protest in the U.S. District Court, Northern District of California, Case 3:03-cv-01335.

Enclosed is Protester's Information Disclosure Statement (PTO 1449) listing 11 U.S. patents and 1 publication which, individually or in various combinations, are believed to clearly render each of the claims of the Degner '456 Patent invalid under 35 U.S.C. 102(b), 103 or 112, 2nd paragraph. Copies of the 11 patents, along with a reproduction of the cover title page, copyright page, introductory pages, and Chapter 5 of the book McGuire, SEMICONDUCTOR MATERIALS AND PROCESS TECHNOLOGY HANDBOOK, For Very Large Scale Integration (VLSI) and Ultra Large Scale Integration (ULSI), © 1988, are enclosed as prior art references A-K.

A concise explanation of the relevance of each listed prior art reference is presented in the attached CLAIM COMPARISON SHEETS. Each CLAIM COMPARISON SHEET reproduces one or more claims of the Degner '456 Patent on the left-hand side, with the relevant language of each prior art reference and corresponding marked-up drawings on the right-hand side, along with the Protester's conclusions or reasons for the relevance.

The reason for combining more than one claim of the Degner '456 Patent on one sheet or a series of sheets is the fact that the claims are so numerous in the patent that

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many of them, mainly the dependent claims, are identical or nearly identical in content. For example, claims 2 through 17 are dependent upon claim 1, and claims 19 through 32 are dependent upon claim 18, but the contents of these two dependent series of claims are identical or nearly identical. This form of presentation is believed to facilitate the necessary examination of all these claims.

It is noted that only two claims of the Degner '456 Patent, 18 and 33, were indicated by the Reissue Applicant to be involved and requiring reexamination in the reissue process. Those two claims, 18 in particular and 33, as now admitted to be invalid, are the principal claims being asserted by the Reissue Applicant in the District Court litigation, along with all of the other claims of the Degner '456 Patent.

CONSIDERATION OF PROTESTOR'S ARGUMENTS PER MPEP 1901.06

Protestor submits herewith Attachments I, II, III and IV, which are documents filed by the Reissue Applicant, LAM Research Corporation, in the pending District Court, litigation referenced above. These include clear judicial admissions by the Reissue Applicant of the particular pertinence of U.S. Patent 4,385,979 to Pierce et al (hereinafter Pierce '979 Patent). The Reissue Applicant asserted in the litigation that the Pierce '979 Patent clearly teaches shrink fitting of an electrode to its support for use in plasma processing systems. This admission clearly invalidates claims 1, 18, 33, 34,

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35, and 36 of the Degner '456 Patent.

A further need for the careful review of each of the claims of the Degner '456 Patent is the fact that the Reissue Applicant is asserting vigorously in the pending District Court litigation that the Degner '456 Patent discloses and claims "bonding" of the electrode to its supporting ring "may be by any suitable process", including shrink fit. See Attachment III, Page 5, lines 4-28. That interpretation flies in the face of the numerous prior art references, References A-K, provided by the Protester, which reflect the many forms of electrode bonding well known in exactly the same art before the Reissue Applicant's perceived invention.

The only difference between the Degner '456 Patent and the Pierce '979 Patent is that in the Degner '456 Patent, the electrode is of substantially uniform thickness, whereas in the Pierce '979 Patent, the electrode is shaped. In this field, flat electrodes are typically used in etching systems, whereas shaped electrodes are used in deposition systems. However, Degner '456 Patent states that its electrode bonding system may be used in either etching or deposition systems. See Degner '456 patent, Abstract, sentence 1 and Col. 1, lines 6-11.

As a further ground for this Protest, it is submitted that the error in claim 18, which gives rise to the Reissue Application, and the error in claim 33, likewise amended

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to overcome an error, were of the type that were apparent on their face as soon as the Degner '456 Patent issued in 1991. Thirteen years later Reissue is sought. The Reissue Applicant brought suit for infringement and asserted claim 18 vigorously as enforceable at least six months before this Reissue Application was filed. At that time, the Reissue Applicant relied upon the Pierce '979 Patent in reality to support a broadened claim construction covering any form of bonding of plasma electrodes to their support, well beyond the two-year limit for a broadening reissue. The Pierce '979 Patent, our Ref. A, is believed to invalidate claim 18 as well as all other claims under 35 U.S.C. 102(b) alone or under 35 U.S.C. 103 in combination with the other references cited by the Protester.

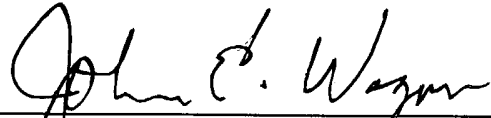
In this Protest, relevant prior art patents are identified by the full patent number and name on the Information Disclosure Statement. Thereafter, they are also designated by Protester's reference designations of Ref. A and C through K, as well as inventor's name and last three digits of the patent number, for example, Ref. A Pierce et al. '979.

References to rejection of several claims under 35 U.S.C. 112 are indicated to mean that the claims lack definiteness or are unallowable Markush-type claims, for example, claims 16, 30, and 35. MPEP 2173.05 (h) or original claims 18 and 33 MPEP 2173.05(a).

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It is requested that in Reissue prosecution, that the Examiner carefully considers References A-K, apply them to the claims and reject claims 1-36 of the Degner '456 Patent.

Respectfully submitted,

 5/8/07

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Enclosures: